ESTTA Tracking number: **ESTTA495920**

Filing date: **09/21/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77844736
Applicant	Apple Inc.
Applied for Mark	OPENCL
Correspondence Address	GLENN A GUNDERSEN DECHERT LLP CIRA CENTRE, 2929 ARCH STREET PHILADELPHIA, PA 19104-2183 UNITED STATES trademarks@dechert.com, glenn.gunderson@dechert.com, hal.borden@dechert.com, jacob.bishop@dechert.com, trademarks@dechert.com
Submission	Request for Reconsideration
Attachments	OPENCL (Color Logo Application) (SN 77844736) -- Request for Reconsideration of Board's Decision.pdf (4 pages)(89430 bytes) OPENCL request for reconsideration -- Exhibits A-B.pdf (51 pages)(2158734 bytes)
Filer's Name	Jacob Bishop
Filer's e-mail	trademarks@dechert.com, glenn.gundersen@dechert.com, jacob.bishop@dechert.com
Signature	/Jacob Bishop/
Date	09/21/2012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Applications of		:
Apple Inc.		:
		:
Mark:	OPENCL	:
Serial No.:	77/616,247	:
Filing Date:	November 17, 2008	:
		:
Mark:	OPENCL & Design (black/white)	:
Serial No.:	77/844,718	:
Filing Date:	October 8, 2009	:
		:
Mark:	OPENCL & Design (color)	:
Serial No.:	77/844,736	:
Filing Date:	October 8, 2009	:

APPLICANT'S REQUEST FOR RECONSIDERATION WITH RESPECT TO APPLICATION SERIAL NO. 77/844,736

On August 28, 2012, the Board issued a decision in the above-captioned *ex parte* appeal, in which the Board withdrew the examining attorney's requirement that Applicant Apple Inc. ("Apple") disclaim exclusive rights in the term OPENCL, but affirmed the examining attorney's refusal to register both Application Serial No. 77/844,718 (as defined below, the "B/W Logo Application") and Application Serial No. 77/844,736 (as defined below, the "Color Logo Application"), on the grounds that Apple's submitted specimen did not show use of the applied-for marks in connection with the applied-for goods. In accordance with 37 §CFR 2.144 and TBMP §1219.01, Apple respectfully requests that the Board reconsider the specimen refusal solely as it pertains to the Color Logo Application, on the grounds that the examining attorney never issued a specimen refusal with respect to the Color Logo Application, because Apple never submitted a specimen of use during prosecution of the Color Logo Application.

As the Board is aware, Apple filed three separate applications for its OPENCL mark:

- an application for the OPENCL word mark (Serial No. 77/616,247) (the "Word Mark Application");
- an application for the black-and-white OPENCL logo (Serial No. 77/844,718) (the "B/W Logo Application"); and
- an application for the color OPENCL logo (Serial No. 77/844,736) (the "Color Logo Application").

During the prosecution of the Word Mark Application and the B/W Logo Application, Apple submitted specimens showing use of the applied-for marks, and claimed Section 1(a) of the Trademark Act as the filing basis for these applications. However, Apple filed the Color Logo Application based on an intent to use the mark in commerce under Section 1(b) of the Trademark Act, and did not submit a specimen of use at any point during the prosecution of the application. See **Exhibit A**.

The examining attorney refused registration of both the Word Mark Application and the B/W Logo Application on the grounds that the submitted specimens did not show use of the mark for the goods listed in the registration. The examining attorney also refused registration of all three OPENCL applications on the grounds that the term OPENCL is merely descriptive for Apple's goods. Apple appealed the examining attorney's refusal to register all three applications, and asked the Board to consolidate the proceedings given the descriptiveness refusal common to all three applications, and the specimen refusals common to both the Word Mark Application and the B/W Logo Application. The Board consolidated the proceedings on

September 30, 2011, and Apple and the examining attorney both presented a single brief supporting their respective positions.[1]

In the August 28, 2012 decision, the Board determined that the specimen submitted with the B/W Logo Application does not show use of the applied-for mark in connection with Apple's goods, and therefore upheld the examining attorney's refusal of the B/W Logo Application specimen. However, the decision erroneously assumes that Apple also submitted this specimen for the Color Logo Application when, as indicated above, Apple never filed a specimen of use for the Color Logo Application.

By filing this Request for Reconsideration, Apple is not requesting the Board to reconsider its conclusion that Apple's specimen is unacceptable to prove use for the B/W Logo Application. However, because Apple never submitted this specimen or any other specimen to support registration of the Color Logo Application, the Board's refusal to register the Color Logo Application, on the grounds that Apple's specimen is unacceptable, constitutes a clear error. As such, Apple respectfully requests that the Board revise its August 28, 2012 decision to clarify that its specimen refusal only applies to the B/W Logo Application and not the Color Logo Application, and instruct the Trademark Office to issue a Notice of Allowance for the Color Logo Application.

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[1] In Applicant's Motion to Consolidate and Applicant's Appeal Brief, Apple erroneously stated that the examining attorney issued specimen refusals with respect to all three OPENCL applications, rather than just the Word Mark Application and the B/W Logo Application. On the other hand, the examining attorney's appeal brief indicates that his refusal of Apple's specimens only applied to the Word Mark Application and the B/W Logo Application. See **Exhibit B**.

Dated September 21, 2012

Respectfully submitted,

Glenn A. Gundersen
Hal Borden
Jacob Bishop
Dechert LLP
Cira Centre
2929 Arch Street
Philadelphia, PA 19104-2808
Telephone: 215.994.2183
Fax: 215.655.2183
trademarks@dechert.com

Attorney for Applicant
APPLE INC.

Exhibit A

Trademark Status & Document Retrieval (TSDR)

US Serial No | 77844736 | Status | Documents

Advanced Search

19 document(s) found

STATUS | DOCUMENTS | View Proceeding | Download | Print Preview

Select All	Create/Mail Date	Document Description	Document Type
☐	Jan. 30, 2012	Offc Action Outgoing	XML
☐	Aug. 16, 2011	Reconsideration Letter	MULTI
☐	Aug. 10, 2011	Amendment and Mail Process Complete	MULTI
☐	Aug. 02, 2011	TEAS Request Reconsideration after FOA	MULTI
☐	Feb. 01, 2011	Offc Action Outgoing	MULTI
☐	Jan. 13, 2011	Amendment and Mail Process Complete	MULTI
☐	Dec. 20, 2010	Preliminary Amendment	XML
☐	Nov. 30, 2010	Amendment and Mail Process Complete	MULTI
☐	Nov. 26, 2010	Response to Office Action	MULTI
☐	May 25, 2010	Notation to File	XML
☐	May 25, 2010	Offc Action Outgoing	MULTI
☐	May 13, 2010	Amendment and Mail Process Complete	MULTI
☐	May 11, 2010	Response to Office Action	XML
☐	Nov. 12, 2009	Notation to File	XML
☐	Nov. 12, 2009	Offc Action Outgoing	MULTI
☐	Nov. 10, 2009	XSearch Search Summary	XML
☐	Oct. 16, 2009	Design Search Code Corr Project	XML
☐	Oct. 08, 2009	Application	MULTI
☐	Oct. 08, 2009	Drawing	JPEG

PTO Form 1478 (Rev 9/2006)
OMB No. 0651-0009 (Exp 12/31/2011)

Trademark/Service Mark Application, Principal Register

Serial Number: 77844736
Filing Date: 10/08/2009

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77844736
MARK INFORMATION	
***MARK**	\\TICRS\EXPORT8\IMAGEOUT8\778\447\77844736\xml1\AP P0002.JPG
SPECIAL FORM	YES
USPTO-GENERATED IMAGE	NO
LITERAL ELEMENT	OpenCL
COLOR MARK	YES
COLOR(S) CLAIMED (If applicable)	The color(s) green, yellow, red, gray, white and black is/are claimed as a feature of the mark.
***DESCRIPTION OF THE MARK (and Color Location, if applicable)**	The mark consists of a speedometer design and the word mark OpenCL.
PIXEL COUNT ACCEPTABLE	YES
PIXEL COUNT	330 x 332
REGISTER	Principal
APPLICANT INFORMATION	
***OWNER OF MARK**	Apple Inc.
***STREET**	1 Infinite Loop
***CITY**	Cupertino
***STATE (Required for U.S. applicants)**	California
***COUNTRY**	United States
***ZIP/POSTAL CODE (Required for U.S. applicants only)**	95014

LEGAL ENTITY INFORMATION	
TYPE	corporation
STATE/COUNTRY OF INCORPORATION	California
GOODS AND/OR SERVICES AND BASIS INFORMATION	
INTERNATIONAL CLASS	009
***IDENTIFICATION**	Application programming interface computer software for use in developing applications for execution on central processing units (CPU) or graphic processor units (GPU)
FILING BASIS	SECTION 1(b)
FILING BASIS	SECTION 44(d)
FOREIGN APPLICATION NUMBER	40957
FOREIGN APPLICATION COUNTRY	Trinidad and Tobago
FOREIGN FILING DATE	05/08/2009
ATTORNEY INFORMATION	
NAME	Lisa G. Widup
FIRM NAME	Apple Inc.
STREET	1 Infinite Loop, MS 3TM
CITY	Cupertino
STATE	California
COUNTRY	United States
ZIP/POSTAL CODE	95014
OTHER APPOINTED ATTORNEY	Thomas R. La Perle, John Donald
CORRESPONDENCE INFORMATION	
NAME	Lisa G. Widup
FIRM NAME	Apple Inc.
STREET	1 Infinite Loop, MS 3TM
CITY	Cupertino
STATE	California
COUNTRY	United States
ZIP/POSTAL CODE	95014

FEE INFORMATION	
NUMBER OF CLASSES	1
FEE PER CLASS	325
***TOTAL FEE DUE**	325
***TOTAL FEE PAID**	325
SIGNATURE INFORMATION	
SIGNATURE	/Lisa G. Widup/
SIGNATORY'S NAME	Lisa G. Widup
SIGNATORY'S POSITION	Intellectual Property Counsel
DATE SIGNED	10/08/2009

PTO Form 1478 (Rev 9/2006)
OMB No. 0651-0009 (Exp 12/31/2011)

Trademark/Service Mark Application, Principal Register

Serial Number: 77844736
Filing Date: 10/08/2009

To the Commissioner for Trademarks:

MARK: OpenCL (stylized and/or with design, see mark)

The literal element of the mark consists of OpenCL.
The color(s) green, yellow, red, gray, white and black is/are claimed as a feature of the mark. The mark consists of a speedometer design and the word mark OpenCL.
The applicant, Apple Inc., a corporation of California, having an address of

1 Infinite Loop
Cupertino, California 95014
United States

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

International Class 009: Application programming interface computer software for use in developing applications for execution on central processing units (CPU) or graphic processor units (GPU)
Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

Priority based on foreign filing: Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and/or services and asserts a claim of priority based on Trinidad and Tobago application number 40957, filed 05/08/2009. 15 U.S.C. Section 1126(d), as amended.

The applicant's current Attorney Information:
Lisa G. Widup and Thomas R. La Perle, John Donald of Apple Inc.

1 Infinite Loop, MS 3TM
Cupertino, California 95014
United States

The applicant's current Correspondence Information:

Lisa G. Widup
Apple Inc.
1 Infinite Loop, MS 3TM

Cupertino, California 95014

A fee payment in the amount of $325 has been submitted with the application, representing payment for 1 class(es).

Declaration

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /Lisa G. Widup/ Date Signed: 10/08/2009
Signatory's Name: Lisa G. Widup
Signatory's Position: Intellectual Property Counsel

RAM Sale Number: 3862
RAM Accounting Date: 10/09/2009

Serial Number: 77844736
Internet Transmission Date: Thu Oct 08 17:33:45 EDT 2009
TEAS Stamp: USPTO/BAS-17.193.15.207-2009100817334564
2738-77844736-4602bd3ccd112582e7682373ef
7abeab31-DA-3862-20091008172455518976

OpenCL

PTO Form 1957 (Rev 9/2005)
OMB No. 0651-0050 (Exp. 04/30/2011)

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77844736
LAW OFFICE ASSIGNED	LAW OFFICE 102
MARK SECTION (no change)	
ARGUMENT(S)	

Filing Basis

Applicant does not intend to rely on Section 44(e) as a basis for registration, and requests that the mark be approved for publication based solely on the Section 1(b) basis, while retaining the Section 44(d) priority claim.

Advisory?Computer Language Not Goods in Trade

The Examining Attorney has advised that, upon consideration of an allegation of use, registration may be refused on the basis that an ?application programming interface? does not constitute ?goods in trade.? Applicant, Apple Inc. (?Apple?), respectfully disagrees.

Apple has applied to register its mark for ?application programming interface computer software for use in developing applications for execution on central processing units (CPU) or graphic processor units (GPU).? The Trademark Office?s Acceptable Identification of Goods and Services Manual includes two different identifications that feature the phrase ?application programming interface?:

- Application service provider featuring application programming interface (API) software for use in building software applications
- Application service provider featuring application programming interface (API) software for allowing data retrieval, upload, access and management

Indeed, the phrase ?application programming interface? appears in more than eighty registered and published federal marks, most of which cover Class 9?including Apple?s own allowed application for the word mark OPENCL (SN 77/616,247). The following are just a few other examples:

· MESA Q-LINK (RN 3030264), registered for ?computer software, namely, an application programming interface linking proprietary bookkeeping software with various other software applications?

· PXML (RN 3677861), registered for ?software, namely, an application programming interface for printers to enable software programmers to integrate printer management features into computer software?

· RESOURCENET (RN 3572168), registered for ?application programming interface software, namely, software to identify specific applications contained on a network and to build a framework for the purpose of distributing those applications.?

· PRESORT OBJECT (RN 3420990), registered for ?application Programming Interface (API) software that serves as a database management tool for performing postal presort functions.?

· SUCCESSCLOUD (SN 77825278), published for ?application programming interface (API) for use in data retrieval, uploading, formatting, sharing, transfer, access and management,? and three other types of API software

In arguing that an ?application programming interface? does not qualify as ?goods in trade,? the Examining Attorney has noted that ?incidental items used to conduct daily business, such as letterhead, invoices, and business forms, provide use and utility only to applicant and are generally not goods applicant sells or distributes to consumers for their use.? Apple?s goods clearly do not fall into this category of ?incidental items.? The application programming interface (API) software identified by the mark is sold as an integral part of Apple?s Snow Leopard operating system, and is used by third-party computer programmers around the world.

Apple has not applied to register its mark as the name of a computing language, but as a mark for a type of software (i.e., an application programming interface) that is covered in numerous other registered marks. The Examining Attorney has focused on a reference to OPENCL as a programming language on Apple?s website, but this reference is not inconsistent with the fact that the mark functions as an indicator of source for Apple?s application programming interface (API) software. Even is one assumes for the sake of argument that a computer language does not qualify as goods in trade, there is no basis for denying that application programming interface software qualifies as goods in trade, and that Apple is using its mark for those goods.

Apple respectfully requests that the application be approved for publication.

ADDITIONAL STATEMENTS SECTION	
DESCRIPTION OF THE MARK (and Color Location, if applicable)	The mark consists of the design of a speedometer, with a gray needle and a dial consisting of quadrilaterals, the color of which changes from green to yellow to orange to red from left to right. Below the gauge, the wording OpenCL appears in black.
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Lisa G. Widup/
SIGNATORY'S NAME	

SIGNATORY'S NAME	Lisa G. Widup
SIGNATORY'S POSITION	Intellectual Property Counsel
DATE SIGNED	05/11/2010
AUTHORIZED SIGNATORY	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Tue May 11 18:31:00 EDT 2010
TEAS STAMP	USPTO/ROA-17.193.14.218-20100511183100654271-77844736-46023573f4349236c6b48686c9a5cc8a77-N/A-N/A-20100511181715470985

PTO Form 1957 (Rev 9/2005)
OMB No. 0651-0050 (Exp. 04/30/2011)

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **77844736** has been amended as follows:

ARGUMENT(S)
In response to the substantive refusal(s), please note the following:

Filing Basis

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use in building software applications

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· PRESORT OBJECT (RN 3420990), registered for ?application Programming Interface (API) software that serves as a database management tool for performing postal presort functions.?

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Apple respectfully requests that the application be approved for publication.

ADDITIONAL STATEMENTS

Description of mark

The mark consists of the design of a speedometer, with a gray needle and a dial consisting of quadrilaterals, the color of which changes from green to yellow to orange to red from left to right. Below the gauge, the wording OpenCL appears in black.

SIGNATURE(S)

Response Signature

Signature: /Lisa G. Widup/ Date: 05/11/2010
Signatory's Name: Lisa G. Widup
Signatory's Position: Intellectual Property Counsel

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

Serial Number: 77844736
Internet Transmission Date: Tue May 11 18:31:00 EDT 2010
TEAS Stamp: USPTO/ROA-17.193.14.218-2010051118310065
4271-77844736-46023573f4349236c6b48686c9
a5cc8a77-N/A-N/A-20100511181715470985

PTO Form 1957 (Rev 9/2005)
OMB No. 0651-0050 (Exp. 04/30/2011)

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77844736
LAW OFFICE ASSIGNED	LAW OFFICE 102
MARK SECTION (no change)	
ARGUMENT(S)	
Disclaimer The Examining Attorney has asserted that OPENCL is the generic name of an ope	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_9624581194-185417442_._OPENCL_technical_brief.pdf
CONVERTED PDF FILE(S) (5 pages)	\\TICRS\EXPORT11\IMAGEOUT11\778\447\77844736\xml1\ROA0002.JPG
	\\TICRS\EXPORT11\IMAGEOUT11\778\447\77844736\xml1\ROA0003.JPG
	\\TICRS\EXPORT11\IMAGEOUT11\778\447\77844736\xml1\ROA0004.JPG
	\\TICRS\EXPORT11\IMAGEOUT11\778\447\77844736\xml1\ROA0005.JPG
	\\TICRS\EXPORT11\IMAGEOUT11\778\447\77844736\xml1\ROA0006.JPG
ORIGINAL PDF FILE	evi_9624581194-185417442_._Khronos_Letter_re_OPENCL.pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT11\IMAGEOUT11\778\447\77844736\xml1\ROA0007.JPG
GOODS AND/OR SERVICES SECTION (current)	
INTERNATIONAL CLASS	009
DESCRIPTION	
Application programming interface computer software for use in developing applications for execution on central processing units (CPU) or graphic processor units (GPU)	
FILING BASIS	Section 1(b)
FILING BASIS	Section 44(d)

FOREIGN APPLICATION NUMBER	40957
FOREIGN APPLICATION COUNTRY	Trinidad and Tobago
FOREIGN FILING DATE	05/08/2009
GOODS AND/OR SERVICES SECTION (proposed)	
INTERNATIONAL CLASS	009
TRACKED TEXT DESCRIPTION	
~~Application programming interface computer software for use in developing applications for execution on central processing units (CPU) or graphic processor units (GPU)~~; Application programming interface computer software for use in developing applications for execution on central processing units (CPU), sold as an integral component of computer operating software.	
FINAL DESCRIPTION	
Application programming interface computer software for use in developing applications for execution on central processing units (CPU), sold as an integral component of computer operating software.	
FILING BASIS	Section 1(b)
FILING BASIS	Section 44(d)
FOREIGN APPLICATION NUMBER	40957
FOREIGN APPLICATION COUNTRY	Trinidad and Tobago
FOREIGN FILING DATE	05/08/2009
SIGNATURE SECTION	
RESPONSE SIGNATURE	/thomas r. la perle/
SIGNATORY'S NAME	Thomas R. La Perle
SIGNATORY'S POSITION	Director, Trademark Copyright & Enforcement
DATE SIGNED	11/26/2010
AUTHORIZED SIGNATORY	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Fri Nov 26 19:00:43 EST 2010
	USPTO/ROA-96.245.81.194-2

TEAS STAMP	010112619004305634 7-77844 736-4706688d769fa2e61cc32 61e5142bffc89-N/A-N/A-201 01126185417442992

PTO Form 1957 (Rev 9/2005)
OMB No. 0651-0050 (Exp. 04/30/2011)

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **77844736** has been amended as follows:

ARGUMENT(S)
In response to the substantive refusal(s), please note the following:

Disclaimer The Examining Attorney has asserted that OPENCL is the generic name of an open

EVIDENCE

Original PDF file:
evi_9624581194-185417442_._OPENCL_technical_brief.pdf
Converted PDF file(s) (5 pages)
Evidence-1
Evidence-2
Evidence-3
Evidence-4
Evidence-5
Original PDF file:
evi_9624581194-185417442_._Khronos_Letter_re_OPENCL.pdf
Converted PDF file(s) (1 page)
Evidence-1

CLASSIFICATION AND LISTING OF GOODS/SERVICES
Applicant proposes to amend the following class of goods/services in the application:
Current: Class 009 for Application programming interface computer software for use in developing applications for execution on central processing units (CPU) or graphic processor units (GPU)
Original Filing Basis:
Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Filing Basis: Section 44(d), Priority based on foreign filing: Applicant has a bona fide intention to use

the mark in commerce on or in connection with the identified goods and/or services, and asserts a claim of priority based on [Trinidad and Tobago application number 40957 filed 05/08/2009]. 15 U.S.C.Section 1126(d), as amended.

Proposed:
Tracked Text Description: ~~Application programming interface computer software for use in developing applications for execution on central processing units (CPU) or graphic processor units (GPU)~~;
Application programming interface computer software for use in developing applications for execution on central processing units (CPU), sold as an integral component of computer operating software.

Class 009 for Application programming interface computer software for use in developing applications for execution on central processing units (CPU), sold as an integral component of computer operating software.
Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Filing Basis: Section 44(d), Priority based on foreign filing: Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and/or services, and asserts a claim of priority based on [Trinidad and Tobago application number 40957 filed 05/08/2009]. 15 U.S.C.Section 1126(d), as amended.

SIGNATURE(S)
Response Signature
Signature: /thomas r. la perle/ Date: 11/26/2010
Signatory's Name: Thomas R. La Perle
Signatory's Position: Director, Trademark Copyright & Enforcement

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

Serial Number: 77844736
Internet Transmission Date: Fri Nov 26 19:00:43 EST 2010
TEAS Stamp: USPTO/ROA-96.245.81.194-20101126190043056347-77844736-4706688d769fa2e61cc3261e5142bffc89-N/A-N/A-20101126185417442992

PTO Form 1966 (Rev 5/2006)
OMB No. 0651-0050 (Exp. 04/30/2011)

Preliminary Amendment

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77844736
LAW OFFICE ASSIGNED	LAW OFFICE 102
MARK SECTION (no change)	
GOODS AND/OR SERVICES SECTION (current)	
INTERNATIONAL CLASS	009
DESCRIPTION	
Application programming interface computer software for use in developing applications for execution on central processing units (CPU), sold as an integral component of computer operating software	
FILING BASIS	Section 1(b)
FILING BASIS	Section 44(d)
FOREIGN APPLICATION NUMBER	40957
FOREIGN APPLICATION COUNTRY	Trinidad and Tobago
FOREIGN FILING DATE	05/08/2009
GOODS AND/OR SERVICES SECTION (proposed)	
INTERNATIONAL CLASS	009
TRACKED TEXT DESCRIPTION	
~~Application programming interface computer software for use in developing applications for execution on central processing units (CPU), sold as an integral component of computer operating software~~; Application programming interface computer software for use in developing applications for execution on central processing units (CPU) or graphic processor units (GPU), sold as an integral component of computer operating software	
FINAL DESCRIPTION	
Application programming interface computer software for use in developing applications for execution on central processing units (CPU) or graphic processor units (GPU), sold as an integral component of computer operating software	
FILING BASIS	Section 1(b)
FILING BASIS	Section 44(d)

FOREIGN APPLICATION NUMBER	40957
FOREIGN APPLICATION COUNTRY	Trinidad and Tobago
FOREIGN FILING DATE	05/08/2009
ADDITIONAL STATEMENTS SECTION	
MISCELLANEOUS STATEMENT	Applicant filed an office action response on November 26, 2010 in which it, among other things, submitted an amendment to the identification of goods. The submitted amendment inadvertently omitted the term "or graphic processor units (GPU)," which was included in the original identification. Applicant therefore respectfully requests that the identification of goods be amended to read in its entirety as follows: Application programming interface computer software for use in developing applications for execution on central processing units (CPU) or graphic processor units (GPU), sold as an integral component of computer operating software.
SIGNATURE SECTION	
RESPONSE SIGNATURE	/thomas r. la perle/
SIGNATORY'S NAME	Thomas R. La Perle
SIGNATORY'S POSITION	Director, Trademark Copyright & Enforcement
DATE SIGNED	12/20/2010
AUTHORIZED SIGNATORY	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Mon Dec 20 16:23:18 EST 2010
TEAS STAMP	USPTO/PRA-204.155.226.3-20101220162318136247-77844736-47064aadbd86f815cf15aeb88a41126f16-N/A-N/A-20101220161637207035

PTO Form 1966 (Rev 5/2006)
OMB No. 0651-0050 (Exp. 04/30/2011)

Preliminary Amendment

To the Commissioner for Trademarks:

Application serial no. **77844736** has been amended as follows:

CLASSIFICATION AND LISTING OF GOODS/SERVICES
Applicant proposes to amend the following class of goods/services in the application:
Current: Class 009 for Application programming interface computer software for use in developing applications for execution on central processing units (CPU), sold as an integral component of computer operating software
Original Filing Basis:
Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Filing Basis: Section 44(d), Priority based on foreign filing: Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and/or services, and asserts a claim of priority based on [Trinidad and Tobago application number 40957 filed 05/08/2009]. 15 U.S.C.Section 1126(d), as amended.

Proposed:
Tracked Text Description: ~~Application programming interface computer software for use in developing applications for execution on central processing units (CPU), sold as an integral component of computer operating software~~; Application programming interface computer software for use in developing applications for execution on central processing units (CPU) or graphic processor units (GPU), sold as an integral component of computer operating software

Class 009 for Application programming interface computer software for use in developing applications for execution on central processing units (CPU) or graphic processor units (GPU), sold as an integral component of computer operating software
Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Filing Basis: Section 44(d), Priority based on foreign filing: Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and/or services, and asserts a claim of priority based on [Trinidad and Tobago application number 40957 filed 05/08/2009]. 15 U.S.C.Section 1126(d), as amended.

ADDITIONAL STATEMENTS
Applicant filed an office action response on November 26, 2010 in which it, among other things, submitted an amendment to the identification of goods. The submitted amendment inadvertently omitted the term "or graphic processor units (GPU)," which was included in the original identification. Applicant therefore respectfully requests that the identification of goods be amended to read in its entirety as follows: Application programming interface computer software for use in developing applications for execution on central processing units (CPU) or graphic processor units (GPU), sold as an integral component of computer operating software.

SIGNATURE(S)
Voluntary Amendment Signature
Signature: /thomas r. la perle/ Date: 12/20/2010
Signatory's Name: Thomas R. La Perle
Signatory's Position: Director, Trademark Copyright & Enforcement

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

Serial Number: 77844736
Internet Transmission Date: Mon Dec 20 16:23:18 EST 2010
TEAS Stamp: USPTO/PRA-204.155.226.3-20101220162318136247-77844736-47064aadbd86f815cf15aeb88a41126f16-N/A-N/A-20101220161637207035

Exhibit B

ESTTA Tracking number: **ESTTA457749**

Filing date: **02/21/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77844736
Applicant	Apple Inc.
Applied for Mark	OPENCL
Correspondence Address	GLENN A GUNDERSEN DECHERT LLP CIRA CENTRE, 2929 ARCH STREET PHILADELPHIA, PA 19104-2183 UNITED STATES trademarks@dechert.com, glenn.gunderson@dechert.com, hal.borden@dechert.com, jacob.bishop@dechert.com, trademarks@dechert.com
Submission	Reply Brief
Attachments	OPENCL (consolidated appeal) -- reply brief.pdf (10 pages)(1706037 bytes)
Filer's Name	Jacob Bishop
Filer's e-mail	trademarks@dechert.com
Signature	/Jacob Bishop/
Date	02/21/2012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Applications of Apple Inc.		: :
Mark:	OPENCL	:
Serial No.:	77/616,247	:
Filing Date:	November 17, 2008	:
Mark:	OPENCL & Design (black/white)	:
Serial No.:	77/844,718	:
Filing Date:	October 8, 2009	:
Mark:	OPENCL & Design (color)	:
Serial No.:	77/844,736	:
Filing Date:	October 8, 2009	:

APPLICANT'S REPLY BRIEF

Applicant Apple Inc. ("Apple") respectfully submits this brief in response to the Examining Attorney's Appeal Brief.

In the course of the prosecution of these applications, Apple has provided extensive evidence demonstrating that (1) Apple created a technical framework to allow computer programmers to write software, (2) Apple fostered the development of an open standard to implement the creation of software under this technical framework, (3) Apple licenses the use of the mark OPENCL in connection with the implementation of the standard, (4) Apple uses OPENCL as its mark for its own application program interface software, and (5) the industry perceives OPENCL as an indicator of source and an Apple trademark.

In a highly specialized and esoteric technical field such as this, it's appropriate for an Examining Attorney to be cautious to ensure that an applicant does not obtain trademark

registration for a term that rightly belongs in the public domain. However, at each stage in the prosecution of these applications, Apple has provided extensive information and documentation, including affidavits from third parties with unquestioned knowledge and expertise in the field, explaining how its OPENCL mark is used and why the relevant public of software developers views OPENCL as an indicator of origin.

The Examining Attorney's Appeal Brief does not rebut Apple's evidence. Instead, it posits an alternate universe, unsupported by any reliable authority, in which OPENCL is merely the "common name of an industry standard" and the "common name of a non-proprietary computing language", and therefore not eligible for registration as a mark for Apple's software.

The Examining Attorney has not presented any credible evidence to support the refusal. Specifically:

- The Examining Attorney has not provided any authority for the assertion that OPENCL "identifies the common name of an industry standard." Instead, this part of the refusal is based solely upon a single definition of "open standard" found on a website called "Building a School Web Site by Wanda Wigglebits", and the Examining Attorney's conjecture based on this single, and clearly unreliable, source.
- The Examining Attorney has not provided any authority for the assertion that OPENCL "identifies the name of a non-proprietary computing language." Instead, this part of the refusal is based upon a single sentence in two press releases from a company called AMD that refer to OPEN CL as a "non-

proprietary industry standard", and the Examining Attorney's conjecture about the meaning of that language.

The core of the Examining Attorney's argument is that because OPENCL refers to an open standard, it therefore must be generic. However, as Apple has demonstrated, one does not follow from the other. The Examining Attorney fails to address the extensive evidence that Apple provided on the nature of open standards, and provides no credible evidence from an authoritative source in the information technology field for the proposition that OPENCL is the common name of an industry standard or the name of a non-proprietary computing language. There is no such evidence in the Examining Attorney's record, because neither of these propositions is true.

Thus, for the reasons set forth in its original brief and in the discussion below, Apple is entitled to register OPENCL as a mark for its software. The fact that OPENCL also identifies an open standard and a computing language does not disqualify the mark from registration. Apple respectfully submits that there is no justification for the premise that OPENCL is descriptive or that Apple's specimens of use are unacceptable, and respectfully requests that the refusal to register and the disclaimer requirements be reversed and the applications approved for registration.

Discussion

I. The term OPENCL is not merely descriptive for Apple's goods.

The Examining Attorney argues that "because Applicant's proposed mark identifies the common generic name of an open standard it cannot also indicate the source of Applicant's

goods." Apple has explained that OPENCL refers to an open standard for the computing industry, as well as Apple's own implementation of the standard, which consists of application program interface (API) software. However, there is no basis for the Examining Attorney's conclusion that OPENCL is the "common generic name" of the standard.

The Examining Attorney cites various definitions of the term "open standard" to support his position. However, none of these definitions establish that the name of an open standard is necessarily generic. In summarizing the various definitions he has cited, the Examining Attorney asserts that "[a]n open standard cannot be changed except by consensus or agreement by members of industry consortium." In the case of OPENCL, the standard cannot be changed by "consensus"; as indicated in the affidavits set forth at Exhibit B and Exhibit C of the Request for Reconsideration on Serial No. 88/616,247, dated August 24, 2011, the OPENCL standard is determined by the Khronos Group, which administers the standard under license from Apple.

The fact that the standard is "open," in the sense that the technology may be used by parties other than the original developer, is entirely consistent with the fact that the name of the standard is associated with a single source. When developers see the term OPENCL in reference to the standard, they know that the mark identifies a standard originated by Apple and administered by its licensee. Simply put, OPENCL is not generic, because it refers to one particular standard developed by one company, Apple, and its licensee. The Examining Attorney has not submitted any evidence to contradict this conclusion.

The Examining Attorney asserts that "all of the definitions provided essentially identify an open standard as a specification that can be freely implemented by all", but that observation is completely consistent with how Apple's OPENCL open standard works – the standard is "open",

in the sense that competing developers can use it to create their own software products. That fact does not preclude trademark protection.

The Examining Attorney also contends that OPENCL is merely descriptive for Apple's goods "because it identifies the common name of a non-proprietary computer language." OPENCL does indeed identify a programming language, but that fact does not make it generic. Just as the Examining Attorney has failed to demonstrate that OPENCL is a "generic common name" for an open standard, he has also failed to show that OPENCL is a "common name" for a language.

The Examining Attorney has provided no credible evidence to support the refusal. On pages 7-8 of his brief, the Examining Attorney relies on brief quotes from material retrieved from NEXIS, but all four of these quotes are presented without attribution or context. In fact, none of them are reliable indicators of perception in the U.S. Only one of the quotes is even from a U.S. source -- Document 9 is from a source called "Vertical News". The other excerpts are from sources in India and Pakistan -- Document 11 is from Animation Xpress (described as an "Indian-focused news portal for animation, VFX, gaming, professionals, students and enthusiasts"); Document 15 is from TendersInfo, a New Delhi-based government procurement website, and Document 17 is from Right Vision News in Karachi, Pakistan. None of these sources can be assumed to have credibility, and even if they were credible, none of them stand for the Examining Attorney's proposition that OPENCL is the common name of a non-proprietary computing language.

The Examining Attorney emphasizes that "[m]ost of the references do not refer to [Apple] or the Khronos Group." This observation, of course, is entirely irrelevant. The fact that

a third-party news article refer to a brand, without mentioning the brand owner, obviously does not transform the brand into a generic term. For example, the Examining Attorney has cited the Indian article that states the following:

> CUDA provides compilers to use common programming languages to write software the GPU rather than the unique specialty languages previously required for graphics programming. CUDA currently supports programming in C, Fortran, OpenCL, Direct Compute, Python, Perl, and Java.

The Examining Attorney has highlighted the term "common programming languages" in bold letters, as if to suggest that the term "common" is significant from a trademark perspective. However, the author of this article obviously uses the term "common" to make a technical distinction between languages that are geared specifically for graphics programming ("specialty") and languages that are not geared specifically for graphics programming ("common"). There is no suggestion whatsoever that OPENCL is the "common name" of a programming language. Indeed, the article refers to OPENCL alongside other languages such as PYTHON, PERL, and JAVA—which are all registered trademarks for software.

Apple has previously noted that numerous third-party software marks are also the names of computer languages. In his appeal brief, the Examining Attorney asserts that "the records of those registrations are not of record here." However, Apple submitted TESS records for nineteen such marks at Exhibit A of its Request for Reconsideration on Serial No. 88/616,247, dated August 24, 2011. In response, the Examining Attorney has cited a handful of registrations in which the names of computer languages were disclaimed, but these registrations do not contradict Apple's position. Simply put, the name of a given computing language may or may not have the capacity to function as a mark for software; there is no *per se* rule against registering the name of a computer language as a trademark. Consequently, the fact that

OPENCL identifies a computer language is not determinative. The Examining Attorney has the burden to demonstrate that the name of this particular computer language, OPENCL, is descriptive for Apple's software, and has failed to meet that burden.

The Examining Attorney also cites four quotes found on NEXIS, shown on page 9 of this brief, all of which are presented without attribution or context. In fact, only one of these quotes is even from a news publication – Document 60, which apparently appeared in Computer Reseller News. The other three quotes (Documents 3, 12, and 24) are not news reporting at all, but quotes from press releases from a single company called AMD.

Two of these press releases are the Examining Attorney sole authority for the premise that the OPENCL is "non-proprietary". The Examining Attorney follows this by citing a definition from Dictionary.com, indicating that "proprietary" means something "manufactured and sold only by the owner of the patent formula, brand name, or trademark associated with the product." However, this cut-and-paste argument proves nothing. Wording found in a single company's press releases does not prove how the industry perceives the OPENCL standard or Apple's mark. Even if the press releases had some relevance, they don't prove the Examining Attorney's premise, because he has taken a single sentence and imbued the term "non-proprietary" with a meaning from the world of trademarks.

The question is not whether the computer language itself is categorized as "proprietary" by commentators, but whether the computing industry recognizes the name of the language as an indicator of source. It's conceivable that an information technology professional might refer to the OPENCL language as "non-proprietary" in the sense that Apple and its licensee, the Khronos Group, invite other parties to use the language in developing their own programs. In other

words, Apple does not assert ownership rights to block others from using the language. However, that does not mean that users perceive the name of the language as a generic term.

In short, OPENCL does not identify a "type" of programming language, or a "class" of programming language; it identifies one particular programming language, originated by one particular company, and further developed by that company's licensee. As such, OPENCL can also function as a mark for that company's software.

II. The specimens show use of OPENCL as a trademark for Apple's goods.

The Examining Attorney contends that Apple's specimens do not show use of the mark on the goods covered by the application, namely, "application programming interface computer operating software for use in developing applications for execution on central processing units (CPU) or graphics processor units (GPU), sold as an integral component of computer operating software." The original specimen consists of a printout of a page from Apple's website that describes Apple's OS X Snow Leopard computer operating system. The page describes various features and components of Snow Leopard, including OPENCL, and displays a button labeled "Buy Now" to allow consumers to order the software online. As discussed in Apple's appeal brief, The Trademark Manual of Examining Procedure (TMEP) expressly contemplates the use of specimens of the type submitted by Apple.

In his appeal brief, the Examining Attorney offers the following summary of his basis for rejecting the specimen:

> [A] close inspection [of the specimen] reveals that OPENCL is identified as "a C-based programming language…." Consequently, the specimen does not show use of the mark to identify Applicant's software. Instead, it merely identifies the

> implementation of the standard programming language. Additionally, a computing language is not software.

This is a non sequitur. Apple has consistently maintained throughout the prosecution of these applications that OPENCL refers to (i) a technical standard for writing computer programs, which was conceived by Apple; (ii) a programming language that is a component of that standard; and (iii) Apple's own implementation of the standard, consisting of the application programming interface (API) software described in the identification of goods. The fact that the specimen refers to the OPENCL programming language is immaterial to whether the specimen also shows use of the mark OPENCL for software.

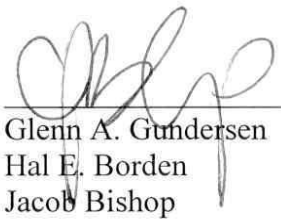
The specimen is a web page that allows consumers to order the Snow Leopard OS X operating system software, and the page prominently displays the mark OPENCL, which identifies API software that is a component of the operating system software. The fact that the specimen does not refer explicitly to OPENCL next to the word "software" is not determinative; there is no requirement of such a reference in the Trademark Office's rules. Apple seeks registration of OPENCL for software "sold as an integral component of computer operating software." The specimen is a web page that displays the mark and provides a means for ordering the computer operating software. As such, it establishes use of the mark for the goods.

Conclusion

For the foregoing reasons and the reasons set forth above in Applicant's appeal brief, Applicant respectfully requests that the mark OPENCL be approved for registration, and that the marks OPENCL and Design be approved for registration without disclaimer.

Date: February 21, 2012

Respectfully submitted,



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Attorneys for Apple Inc.

From: Webster, Michael

Sent: 1/30/2012 9:23:21 PM

To: TTAB EFiling

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 77844736 - OPENCL - N/A - EXAMINER BRIEF

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Attachment Information:
Count: 1
Files: 77844736.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 77844736

MARK: OPENCL

CORRESPONDENT ADDRESS:
GLENN A GUNDERSEN
DECHERT LLP
CIRA CENTRE 2929 ARCH STREET
PHILADELPHIA, PA 19104-2183

GENERAL TRADEMARK INFORMATION:
http://www.uspto.gov/main/trademarks.htm

TTAB INFORMATION:
http://www.uspto.gov/web/offices/dcom/ttab/index.html

APPLICANT: Apple Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:
N/A
CORRESPONDENT E-MAIL ADDRESS:

EXAMINING ATTORNEY'S APPEAL BRIEF

On November 17, 2011, the Applicant, Apple, Inc., submitted an intent-to-use application (serial No. 77616247) to register the standard character mark OPENCL for "computer software; Application programming interface computer software and language definition for uses in developing applications for execution on central processing units (CPU) or graphic processor units (GPU)." On October 8, 2011, Applicant submitted two additional companion applications for the mark OPENCL and design (serial No. 77844718 based on 1(a) and 44(d); and serial No. 77844736 based on 1(b) and 44(d)) for "Application programming interface computer software for use in developing applications for execution on central processing units (CPU) or graphic processor units (GPU)."[1] The design marks were refused because the marks were not used to identify "goods in trade" under Trademark Act Sections 1, 2, 3 and 45, 15 U.S.C. §§1051-1053, 1127. Upon submission of the statement of use, the standard character mark was refused for the same

[1] Applicant subsequently deleted the Section 44(d) basis for serial Nos. 77616247 and 77844736.

reason. For purposes of consistency, the standard character mark was reassigned to the Examining Attorney assigned to the design marks.

After Applicant responded to the initial refusal, the Examining Attorney issued new Office Actions requiring a disclaimer of the term "OPENCL" in the design marks and refusing registration for the standard character mark for mere descriptiveness under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1). The Examining Attorney also refused the specimens for the use-based applications (Nos. 77616247 and 77844718) because they did not show use of the mark as a trademark for the goods identified in the applications. Applicant responded by arguing that the term OPENCL was not descriptive, submitted substitute specimens, and amended the identification of goods to its current form. The requirement for a disclaimer in the design marks and the refusal under Section 2(e)(1) for the standard character mark were then made Final. The refusal of the specimens for failure to show use of the mark as a trademark was also continued and made final for application Nos. 77616247 and 77844718. Applicant subsequently requested reconsideration in each of the applications and appealed all of the remaining issues to the Trademark Trail and Appeal Board. On September 22, 2011, Applicant submitted a motion to consolidate the appeals in the three applications for all purposes and the Board granted the request. This appeal now follows.

ARGUMENTS

I. **The Term OPENCL is Merely Descriptive**

A. <u>The Term OPENCL is Merely Descriptive Because it Identifies the Common Name of an Industry Standard</u>.

Section 1209.01 of the Trademark Manual of Examining procedure states, "matter may be categorized along a continuum, ranging from marks that are highly distinctive to matter that is a generic name for the goods or services." "A mark is considered merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of the specified goods or services." TMEP §1209.01(b). However, generic terms are terms that the relevant purchasing public understands primarily as the common name for the goods or services. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1811 (Fed. Cir. 2001). These terms are incapable of functioning as trademarks and denoting source. TMEP §1209.01(c).

Applicant has applied to register the term OPENCL in standard characters and with design for "Application programming interface computer software for use in developing applications for execution on central processing units (CPU) or graphic processor units (GPU), sold as an integral component of computer operating software." The original specimen submitted for application Nos. 77616247 and 77844718 states, "OpenCL stands for Open Computing Language." (Oct. 29, 2009, Specimen, p.3). The specimen further states, "Best of all, OpenCL is an *open standard* that's supported by the biggest names in the industry, including AMD, Intel, and NVIDIA." (Specimen, p.4).

The Examining Attorney refused the standard character mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), and required a disclaimer of "OPENCL" for the design marks under Section 6, 15 U.S.C. §1056, because OPENCL immediately identifies the common or generic name of an industry standard language and application programming interface. In the Office Action dated September 14, 2011, the Examining Attorney submitted twenty-nine articles from a Lexis database identifying

OPENCL as the name of an "industry standard" or "open standard". (See end of Office Action).[2] The Examining Attorney also submitted several web pages referring to OPENCL as an open industry standard. (Sept. 14, 2011, Office Action, pp. 2-31). Applicant concedes that OPENCL is the name used for an "open standard for the computing industry." Applicant's Brief at 6. However, Applicant disputes the Examining Attorney's conclusion that the name of an *open industry standard* is merely descriptive of the goods with which it is used and cannot also identify the source of Applicant's goods. Brief at 11.

The determination of whether a mark is merely descriptive requires consideration of the significance that the mark would have to the average purchaser of the goods in the marketplace. *See In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987). In the Final Action dated February 24, 2011, the Examining Attorney attached the following references defining the term "standard":

> Standards are the technical specifications and working methods necessary for different vendors' equipment to interoperate. Standards enhance efficiency and usability; however, they do not protect life and limb.[3] (Exhibit 3, p.56).
>
> A specification for hardware or software that is either widely used and accepted (de facto) or sanctioned by a standards organization (de jure).[4] (p. 57).
>
> Standards are necessary for interworking, portability, and reusability. They may be de facto standards for various communities, or officially recognized national or international standards.[5] (p. 58).

---

[2] All references to **evidence** in the consolidated appeals refer to the page numbers and evidence in Serial No. 77616247 for the standard character mark. Evidence in each case is the same but may not be in the same order or have the same action date.
[3] On-line computer glossary from WestNet learning.
[4] Computer Desktop Encyclopedia copyright ©1981-2009 by The Computer Language Company, Inc.
[5] Provided by FOLDOC – Free Online Dictionary of Computing (foldoc.org)

Contrary to Applicant's assertion on page 10 of its brief, the Examining Attorney has also provided multiple references defining an "open standard". For example, an on-line article from Wikipedia® describing open standards submitted with the August 2, 2010 Office Action contains several definitions of "open standard".[6] (Aug. 2, 2010, pp. 48-57). A popular definition credited to Bruce Perens states, "Open Standards create a fair, competitive market for implementations of the standard. They do not lock the customer in to a particular vendor or group." "Open Standards are free for all to *implement*, with no royalty or fee." (p.51). The Open Source Initiative's definition further states that "[a]n 'open standard' must not prohibit conforming implementations in open source software." (p.52). The Digital Standards Organization (DIGISTAN) defines an open standard as "a published specification that is immune to vendor capture at all stages in its life-cycle." (p.53). All of the definitions provided essentially identify an open standard as a specification that can be freely implemented by all and that promotes *competition* because its use cannot be claimed by a single vendor. Similarly, one of the main reasons for not allowing protection of descriptive marks through registration is to prevent the applicant from inhibiting *competition. In re Abcor Dev. Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978).

In its brief, Applicant references an article from wigglebits.com describing how standards are necessary for every day communication. Brief at 10. The Examining Attorney provided the article as evidence because the author thoroughly describes, in simple terms, the meaning and use of standards in various fields. (Aug. 2, 2010, pp. 59-

[6] Articles from the online Wikipedia® encyclopedia may be used to support a refusal or requirement, provided the applicant has an opportunity to rebut such evidence. *See In re IP Carrier Consulting Grp.*, 84 USPQ2d 1028, 1032 (TTAB 2007); TBMP §1208.03; TMEP §710.01(b).

62). The author compares standards to the English language as a means for communication as follows:

> Languages and standards are very similar, they are the means by which people and computers communicate: people via language and computers via standards. Just like society needs a common language to communicate and grow, computers need a common language also. In that way, both the signal senders and the signal receivers will always speak the same language. And just like no one should "own" English, no one should "own" standards, the language of computing. (p. 61).

The author then distinguishes an "open standard" from a "proprietary standard" by stating, "[a]n *open standard* is a published standard that is possessed by no one and used by all. HTML is an open standard; it is managed by the World Wide Web consortium and they see to its dissemination and evolution. But they do not own it, no one does. A *proprietary standard*, on the other hand, is typically owned by a corporation. Its internals cannot be inspected." (p.61)

The evidence in the record therefore indicates that the relevant consumers would view OPENCL as the name of an open standard in the computing industry because of the frequent use of OPENCL with the terms "open standard" and "industry standard". The abundant use in the marketplace identifies the term as the name for an open standard for a computing language and API. Indeed, Applicant and its "licensees" promote OPENCL as an open standard in the computing industry. The multiple descriptions of "open standard" indicate that the significance of the name of an open standard to the relevant consuming public immediately describes a specification used by all for equipment from different vendors to interoperate and to maintain competition in the market. Consequently, the significance that the proposed mark would have to the average

purchaser is that of the common name of an open industry standard or specification that is free to be used by all and will have multiple implementations.

Applicant argues that "open standards are analogous to open source software" and provides examples of registrations that Applicant contends identify open source software that have been registered by the USPTO. Brief at 11. This statement is incorrect. Moreover, registrations for open source software are not relevant to the refusal. Based on the evidence in the record, open standards are analogous to agreed upon blueprints or protocols that must be employed to ensure that things, such as software or hardware, made by different people will work together. An open standard cannot be changed except by consensus or agreement by members of an industry consortium. If a manufacturer wants to compete in an industry, it must adopt the standards and implement the standards into its products so that they may communicate with, or work together with, products from other manufacturers. Therefore, because Applicant's proposed mark identifies the common generic name of an open standard it cannot also indicate the source of Applicant's goods.

B. The Term OPENCL is Merely Descriptive Because it Identifies the Common Name of a Non-Proprietary Computing Language.

The proposed mark OPENCL is also merely descriptive of the identified goods because it identifies the common name of a non-proprietary computing language. "Because a language is not "goods" or "services" under the Act, 15 U.S.C. Section 1127 (1988), a name originated for a new language is inherently not registrable for the language." *The Loglan Inst., Inc. v. Logical Langauge Group, Inc.*, 962 F.2d 1038, 1041,

22 USPQ2d 1531, 1533 (Fed. Cir. 1992). In *Loglan*, the Court upheld Trademark Trial and Appeal Board's cancellation of the term "Loglan" on the grounds that the mark was a generic designation identifying logical language. The Court stated, "a generic name of a language alone cannot function as a trademark to indicate origin of a dictionary describing that language." *Id*. The Court relied on evidence that third parties and the Registrant itself used the term in a generic fashion.

In this case, the Examining Attorney has provided evidence of third-party references to OPENCL as a common open computing language. In the Office Action dated February 24, 2011, the Examining Attorney attached twenty-five articles from a search of a Lexis database referring to OPENCL as an Open Computing Language. Most of the references do not refer to Applicant or the Khronos Group. The articles include the following:

> ArcSoft's products, which are optimized with **OpenCL**, include the upscaling technology SimHD® on TotalMedia Theatre 5 and H.264 encoders across many applications such as TotalMedia ShowBiz, TotalMedia Studio, and MediaConverter 7. With OpenCL-based H.264 encoders, the encoding process takes the full capacity of the entire . . . (Document 9).

> CUDA provides compilers to use **common programming languages** to write software for the GPU rather than the unique specialty **languages** previously required for graphics programming. CUDA currently supports programming in C, C, Fortran, **OpenCL,** Direct Compute, Python, Perl and Java. This list continues to grow with offerings from NVIDIA and third parties. (Document 11).

> IBM has released a Linux development kit for the Open Computing **Language OpenCL. The language,** is seen as vendor agnostic solution to parallel coding **languages** such as Nvidia's Cuda. Even IBM claims that the language "greatly improves speed and responsiveness for a wide spectrum of applications in numerous market categories from gaming and entertainment to scientific and medical software." In IBM's case, it's less of the gaming and more towards the scientific research aspect. (Document 15).

> The **OpenCL industry standard programming language** allows developers to preserve their source code investments and easily target multi-core CPUs, GPUs, and will be supported on the upcoming AMD Fusion APUs. (Document 17).

In addition to Applicant's own promotion of OPENCL as an open standard on the original specimen, Applicant's licensee, the Khrohos Group, also promotes OPENCL as an "open, royalty-free standard for cross-platform, parallel programming". (Aug. 2, 2010 Office Action, p. 8). The definitions of "open standard" in the record support the conclusion that OPENCL is the common name of a computing language used as an industry standard and is not a source-indicator for Applicant's own computer software.

Applicant has submitted several third-party registrations as evidence that the names of computer languages could function as a trademark for computer software. However, "prior decisions in 'descriptiveness' and 'capability' cases, no less decisions of Examiners rather than precedential tribunals are of little help in determining such issues in a given case with its peculiar designation and factual context." *In re Carvel Corporation*, 223 USPQ 65, 66-7 (TTAB 1984). Additionally, the records of those registrations are not of record here. Moreover, the Examining Attorney also provided evidence of third-party registrations where the generic names of the computer languages (BASIC, COBOL, FORTRAN, PASCAL, C+) have been disclaimed. (Exhibit 4, Feb. 24, 2011, pp. 62-77).

In support of registration Applicant cites the non-precedential case *In re Faculdades Catolicas*, Serial No. 77423725 (TTAB, July 10, 2010) where the Board allowed registration of the mark LUA for computer programs recorded on data media . . . for implementing computer programming languages. However, in the that case, the Board found the evidence insufficient to conclude that LUA referred to a particular "type

of programming language as opposed to a particular *proprietary* programming language." *Id*. at 12. Unlike LUA, OPENCL identifies the common name of a non-proprietary, industry standard language. Contrary to Applicant's assertion on page 8 of its brief, the articles attached to the September 12, 2011 denial of reconsideration clearly identify OPENCL as a non-proprietary open computing language. The articles include the following:

> "We are proponents of industry **standards** like **OpenCL** and Bullet Physics because they can simplify programming as well as removing barriers caused by **proprietary** technologies that can restrict developers' creativity," said Sandeep Gupte, general manager, AMD Professional Graphics. (Document 3).
>
> The jointly developed **OpenCL** courses from AMD and Acceleware are designed to support professional software developers by providing ongoing education opportunities around **OpenCL**, the **non-proprietary industry standard** for true heterogeneous computing across platforms. (Document 12).
>
> This effort underscores AMD's commitment to the educational community, which currently includes a number of strategic research initiatives, to enable the next generation of software developers and programmers with the knowledge needed to lead the era of heterogeneous computing. **OpenCL**, the only **non-proprietary industry standard** available today for true heterogeneous computing, helps developers to harness the full compute power of both the CPU and GPU to create innovative applications for vivid computing experiences. (Document 24).
>
> A major difference between the approaches by Nvidia and AMD to GPU computing is that the former has developed its **proprietary** CUDA framework, while the latter says it's committed only to open **standards** like the **OpenCL** heterogeneous programming language that can work on any vendor's hardware. (Document 60).

Additionally, the abundant evidence identifying OPENCL as an "open standard" and "industry standard" supports the conclusion that OPENCL is non-proprietary based on the definitions of "open standard" discussed previously. The definition of "proprietary" from dictionary.com includes: "manufactured and sold *only* by the owner

of the patent formula, brand name, or trademark associated with the product." (Emphasis added). (February 24, 2011, p. 88). Unlike the computing language in *In re Faculdades* Catolicas, the OPENCL open standard language is "free for all to implement" and is not provided only by Applicant. Indeed, the evidence attached to the August 2, 2011 Office Action identifies implementations of the OPENCL standard by several different independent vendors, including AMD®, Nvidia®, RapidMind®, Gallium3D, ZiiLABS, and IBM®. (Aug. 2, 2011, pp. 3-4). Most of these implementations are not software at all, and particularly, not Applicant's software. Consequently, Applicant's use of OPENCL with its operating system software to identify its own implementation of the language merely describes the common generic name of the industry standard and cannot function as a source identifier for software that implements the language.

Applicant argues that the computing industry recognizes OPENCL as a trademark and Applicant has submitted affidavits from two companies who are "licensees" of the proposed mark and have adopted the standard. However, the determination of whether a designation is descriptive or generic depends on how the relevant public understands the term. TMEP §1209.01(c)(i). The parties represented in the affidavits do not represent the relevant public in this case. These "licensees" are manufacturers and providers of computer and graphics processors. They provide their own implementations of the language on their processors in conformance with the standard. The relevant public, in this case, are purchasers of the software, CPU's and GPU's or programmers who need to write programs in the OPENCL language using one of the many implementations of the standard. And given the nature of the mark and the manner in which it is used in

commerce the term OPENCL is merely descriptive because it identifies both the name of an industry standard and a non-proprietary computing language.

II. The Specimens do not Show Use of OPENCL as a Trademark for Computer Software

A. The Term OPENCL, as Used on the Specimens, Identifies a Programming Language, and is not Used to Identify Computer Software.

The specimens of use submitted with application Serial Nos. 77616247 and 77844718 do not show use of the marks OPENCL and OPENCL and design as trademarks in connection with "application programming interface computer operating software for use in developing applications for execution on central processing units (CPU) or graphics processor units (GPU), sold as an integral component of computer operating software." An application for registration under §1(a) of the Trademark Act or an allegation of use in an application under §1(b) of the Act must include one specimen per class showing use of the mark on or in connection with the goods. 15 U.S.C. §§1051(a)(1), 1051(c) and 1051(d)(1); 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a), 2.76(b) and 2.88(b). TMEP §904.

Applicant submitted the same specimen with the statement of use for serial No. 77616247 and the application for serial No. 77844718. The specimen consists of a web page for Applicant's OS X operating system software with the heading "New technologies in Snow Leopard". According to the specimen, the operating system software can be purchased by clicking on a button with the wording "Buy Now" at the top of the page. The proposed mark, OPENCL, appears by scrolling down the web page.

However, a close inspection reveals that OPENCL is identified as "a C-based programming language with a structure that will be familiar to programmers who can simply use Xcode developer tools to adapt their programs to work with OpenCL." (SOU, Oct. 29, 2009, p.5). Consequently, the specimen does not show use of the mark to identify Applicant's software. Instead, it merely identifies the implementation of the standard programming language. Additionally, a computing language is not software. A programming language is "an artificial language" or "a set of grammatical rules" designed to express computations. (See Exhibit 1, Feb. 24, 2011, pp. 2-19).

Applicant argues that the statement on the specimen that "OpenCL automatically optimizes for the kind of graphics processor in the Mac, adjusting itself to the available processing power" is not a description of a programming language. However, this statement does not identify a function of computer software. It identifies the advantages of programming in the OpenCl language and "GPU-based programming". Additionally, the statement on the specimen that "OpenCl makes it possible for developers to tap the vast gigaflops of computing power currently in the graphics processor" merely identifies what's made possible for software developers by programming in OpenCl. It does not identify the function of computer software identified as OpenCl.

In its brief, Applicant provides conflicting statements that OpenCl is in fact used to identify computer software. On page 6, Applicant states, "OPENCL is a *technical framework* that Apple created in order to allow computer programmers to write software with multiple types of processors." (Emphasis added). However, a technical framework identifies a specification for a standard or computing language but does not identify computer software. Additionally, Applicant states, "Apple has developed a computer

language and software that implements that language, and is attempting to register the name that refers to both the language and the software as a trademark *for software* that implements the language." Brief at 8. (Emphasis in original). On the specimen, OPENCL clearly refers to the standard computing language. The software that implements the language is the Mac OS X® operating system software and the trademarks that identify it are Mac OS X® or Snow Leopard®. OPENCL does not refer to this software.

In its August 24, 2011, Request for Reconsideration for the standard character mark in serial No. 77916247, Applicant submitted a substitute specimen only identified as a "screen shot depicting an implementation of the OPENCL API." The specimen appears to show an "example" of use of the language and does not appear to identify a particular software. Moreover, an API is also not software. An API is defined as a "set of routines, protocols and tools for building software applications" or "an interface between the operating system and application programs which includes the way the application programs communicate with the operating system, and the services the operating system makes available to the programs." (Office Action dated Aug. 2, 2010, pp. 64-67). As such, the API is merely a communication interface, or set of rules and specifications to allow software written in OPENCL to communicate with the operating system and other software or hardware. It is an integral feature of the programming language. (See Feb. 24, 2011, Final Action, Exhibit 2, pp. 20-54).

B. <u>OPENCL is Used on the Specimens to Identify an Open Standard, and Therefore, Cannot also Identify the Source of Applicant's Software</u>.

Based on Applicant's specimens and the evidence in the record, the Examining Attorney refused registration because the specimen does not show the applied-for mark in use in commerce as a trademark. 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56; TEMP §§904, 904.07(a). The specimen, along with any other relevant evidence of record, is reviewed to determine whether an applied-for mark is being used as a trademark. *In re Volvo Cars of N. Am., Inc.*, 46 USPQ2d 1455 (TTAB 1998). Applicant's specimen states, "[b]est of all, OpenCL is an open standard that's supported by the biggest names in the industry, including AMD, Intel, and NVIDIA." Because of consumers' understanding of an "open standard", the use of OPENCL on the specimens does not show use of the mark as a trademark.

Applicant's own arguments contradict its position that OPENCL is used as a source indicator for the identified goods. On page 9 of its brief, Applicant states, "[d]evelopers associate the name of an open standard with the organization that *manages and evolves* the standard, and they use the name as a mark to indicate conformance with the criteria developed by that organization." (Emphasis added). Consequently, Applicant admits developers would not associate the name with Applicant, even when used on its operating system. Moreover, the process of *managing* and *evolving* a standard by a non-profit consortium does not indicate the sale or provision of a particular product.

Additionally, the use of OPENCL to indicate conformance with criteria suggests certification of particular criteria and not indication of source. Applicant argues that "when they [developers] see the mark OPENCL in connection with *an implementation* of the standard, they know the implementation has been certified to meet the specifications

promulgated by Khronos." Brief at 9. (Emphasis added). In addition, "[m]embers of Khronos are licensed to use the mark OPENCL in connection with *implementations* of the standard that conform to the specifications, as determined by Khronos. Brief at 6. These statements indicate that there are multiple implementations of the standard in addition to Applicant's implementation. The statements further indicate that the mark certifies conformance with the specifications of the industry standard, consistent with a certification mark.

With its Request for Reconsideration dated, August 24, 2011, Applicant submitted a copy of the "Khronos Trademark Guidelines". (pp. 80-82). In the second paragraph of the first page the guidelines state, "Khronos may make available Certification Logos available for use on fully conformant products." It is clear from the record in this case that the use and promotion of OPENCL will give certification significance to the mark in the marketplace and not identify the source of Applicant's goods. See TMEP §1306.05; *See also, Ex parte Van Winkle*, 117 USPQ 450 (Comm'r Pats. 1958). A mark that functions to certify conformance with a standard cannot also be used to indicate the source of a particular product. TMEP §1306.05. Consequently, Applicant has not submitted evidence of use of the mark as a trademark for the identified goods.

CONCLUSION

The term OPENCL identifies the common generic name of a non-proprietary computing language and an open standard in the computing industry. Therefore, the refusal of the mark under Section 2(e)(1) for serial No. 77646247 and the requirement for

a disclaimer for serial Nos. 77844718 and 77844736 should be affirmed. Additionally, the specimens submitted for the applications based on use in commerce show use of the mark in connection with an open standard computing language and do not identify the goods in the application. Consequently, the refusal of the specimens for failure to show use of the mark as a trademark for the identified goods should be affirmed.

Respectfully submitted,

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